

REMARKS/ARGUMENTS

Rejections Under 3 U.S.C. §112 paragraph 1.

Claim 19 stands rejected under 35 U.S.C §112 paragraph 1 as not being enabled by the specification as filed. MPEP2164 states:

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable?

Applicant respectfully submits that pumice stone carving was well known in the art when the application was filed. Indeed, Applicant includes internet advertisements displaying pumice stones sold in a variety of shapes including an oval, and a thin rectangular box. These advertisements illustrate pumice stone is regularly formed into specific shapes and attached to other structures.

The amount of experimentation required to carve a pumice stone compatible with the present invention, and mechanically attach the carved stone to the claimed invention is minimal, and would probably require no experimentation at all. Accordingly, Applicant respectfully submits claim 19 is enabled by the specification as originally filed, and the rejection should be withdrawn.

Rejections Under 35 U.S.C. §103

The following is a quotation from MPEP chapter 2100:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or

in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claims 1, 2, 9, 10 are rejected under 35 U.S.C. §103(a) as being unpatentable under over US Patent No. 6,730,098 to Chang in view of US Patent No. 3,906,940 to Kawada.

Applicant's amendment to independent claim 1 obviates the *prima facie* case of obviousness is established by the Examiner because the cited prior art, individually or in combination, fails to teach every element of the claim. Nowhere does the prior art teach the invention claimed in independent claim 1 including the newly added limitation for a skin pulling suction cup or an exfoliation tip mechanically coupled to a shaft that is mechanically coupled to the motor, the exfoliation tip being offset or recessed inside a vacuum space formed below the plane delineated by the end of the suction cup. As disclosed in the specification, when the vacuum is pulled, the user's skin penetrates the plane and is pulled partially into the space the offset or recessed distance so the skin and exfoliation tip make contact

Furthermore, US Patent No. 2,232,474 to Rauh which the Examiner cites as disclosing "a soft rubber cup having a ridge defining the opening. The cup also includes enough space to allow the lip to be offset from the ridge." However, Rauh as well as all the prior art cited by the Examiner fails to disclose a vacuum cup forming a skin pulling vacuum when placed in contact with the skin. Thus not every element of the claimed invention is disclosed by the prior art and the rejection under 103 should fail.

In addition, Rauh teaches away from the present invention. Rauh requires the user to press the device into the flesh being massaged to compress the bias spring. In contrast, the

present invention claims a device that contacts skin by pulling the skin into a vacuum chamber. Thus the direction of force for Rauh to operate is the opposite of that claimed by the present invention. It would not have been obvious for one of ordinary skill in the art to utilize a vacuum chamber to make contact between the exfoliating element and skin based on the cited prior art. Accordingly, the amended claim is not obvious in light of the present invention and Applicant respectfully requests the Examiner remove the rejection.

In as much as claims 2, 9, 10 depend either directly or indirectly from claim 1, and claim 1 is allowable, the other referenced claims are also allowable. Accordingly, Applicant respectfully suggests the rejection has been obviated and should be removed.

Similarly, claims 3-8, and 11 and 12 also depend directly from claim 1 and the rejections against these claims should also be withdrawn in light of the amendment to the specification.

Claims 13-18, 20 and 24 stand rejected in view of Kawada and in further view of US Patent No. 6,629,983. Again, the applicant has amended independent claim 13 from which all other rejected claims depend. There is no *prima facie* case for obviousness against amended independent claim 13 and amended independent claim 24 as discussed above. Accordingly, Applicant respectfully requests the objection be removed and the claims be allowed.

In as much as claims 19, 21-23 depend directly from independent claim 13, and independent claim is not obvious, all dependent claims should be allowable as well.

Conclusion

Applicant has submitted evidence showing that carving a pumice stone compatible with the present invention is within the state of the art, would not require undue experimentation, and thus is enabled. Applicant has also amended independent claims 1, 13 and 24 to claim limitations not disclosed in the prior art. The application is thus in condition for allowance and the Applicant respectfully requests a timely Notice of Allowance be issued in this case.

Respectfully submitted,

KIRTON & McCONKIE
Michael F. Krieger

Date: January 28, 2005

By _____

Reg. No. 35,232

Kirton & McConkie
1800 Eagle Gate Tower
60 East South Temple
P.O. Box 45120
Salt Lake City, Utah 84111-1004
Telephone: (801) 328-3600
Fax: (801) 321-4893

Attachments